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MOTOROLA, INC. 1303 EAST ALGONQUIN ROAD IL01/3RD SCHAUMBURG, IL 60196			EXAMINER LEE, PHILIP C	
			ART UNIT	PAPER NUMBER
			2152	
			NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/625,389

Applicant(s)

IDNANI, AJAYKUMAR R.

Examiner

Philip C. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-14 and 16 is/are allowed.
- 6) ☒ Claim(s) 1-9 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. This action is responsive to the amendment and remarks filed on July 5, 2007.
2. Claims 1-9 and 15 are presented for examination.
3. Claims 10-14 and 16 are allowable.
4. The text of those sections of Title 35, U.S. code not included in this office action can be found in a prior office action.

Claim Rejections – 35 USC 112

5. Claims 1-9 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following words or phrases are not clearly understood, rendering the corresponding claim vague or indefinite:

- a) "sending a second registration message for the remote unit to the SIP registrar", claim 1, line 4, and claim 15, line 8. It is unclear if the second registration message is send by the same SIP proxy UA that sends the first registration

message, or another SIP proxy UA; If the same SIP proxy, then it is unclear why two registration messages are sent.

Claim Rejections – 35 USC 101

6. Claim 15 is rejected under 35 U.S.C. 101 because “A radio access network (RAN) component” comprising an interface, a unit and a SIP agent (i.e., software program) does not include any functional structure (hardware) of a RAN component. An apparatus comprising an interface, a unit and agent (i.e., software program) is considered as program per se, which is not one of the categories of statutory subject matter (i.e., a processing unit can include interpretation of a software process, rather than “a processor”).

Claim Rejections – 35 USC 103

7. Claims 1-2, 4-7, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allison et al, U.S. Patent Application Publication 2003/0129991 (hereinafter Allison) in view of Schuster et al, U.S. Patent 6,857,021 (hereinafter Schuster).

8. Allison and Schuster were cited in the previous office action.

9. As per claim 1, Allison teaches the invention substantially as claimed for maintaining contact addresses, the method comprising:

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sending, by a user agent (UA) (114,116, fig. 5), a first registration message for a remote unit (126, fig. 5) to a registrar (300, fig. 5)(page 6, parag. 50);

sending a second registration message for the remote unit to the registrar(page 8, parag. 67);

receiving, in response to the second registration message, a response that indicates a contact address more recent than any provided by the UA (page 8, parag. 67; page 7, parag. 62; fig. 5) (VLR 122 receiving an InsertSubscriberData Message, in response to registration message, the InsertSubscriberData includes Timestamp that indicate a contact address more recent than any provided); and

sending, in response to a update location message (1, fig. 8), a deregistration message (Cancellocation Message, 2, fig. 8) for the remote unit to the registrar (page 8, parag. 68).

10. Allison teaches sending, in response to a message (1, fig. 8), a deregistration message (Cancellocation Message, 2, fig. 8) for the remote unit to the registrar (page 8, parag. 68).

Allison does not specifically teach all type of messages, however, there is no novelty to include sending, in response to a different message such as the received response presented in the instant claim with Allison's system. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to include sending in response to the received response or any other type of messages in order to trigger transmission of CancelLoaction message allowing management of location information.

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11. Allison did not teach a SIP proxy user agent and a SIP registrar. Schuster teaches a SIP proxy user agent and a SIP registrar (col. 14, lines 22-31).

12. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Allison and Schuster because Schuster's teaching of SIP proxy user agent and a SIP registrar would increase the functionality of Allison's system by providing Session Initiation Protocol (SIP) registration management on a network.

13. As per claim 15, Allison teaches the invention substantially as claimed comprising:
a wireless network interface (inherently comprised);
and a processing unit for providing a user agent (114,116, fig. 6), the processing unit communicatively coupled to the wireless network interface (It is inherent that user agent must be communicatively coupled to wireless interface in order to send and receive message in a wireless network) and adapted to receive a registration request from a remote unit via the wireless network interface (page 6, parag. 50), send a first registration message for the remote unit to a registrar (page 6, parag. 50), send a second registration message for the remote unit to the registrar (page 8, parag. 67), receive, in response to the second registration message, a response that indicates a contact address more recent than any provided by the UA (page 7, parag. 62; page 8, parag. 67), and send, in response to a update location message (1, fig. 8), a deregistration message for the remote unit to the registrar (page 8, parag. 68).

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14. Allison teaches sending, in response to a message (1, fig. 8), a deregistration message (Cancellocation Message, 2, fig. 8) for the remote unit to the registrar (page 8, parag. 68).

Allison does not specifically teach all type of messages, however, there is no novelty to include sending, in response to a different message such as the received response presented in the instant claim with Allison's system. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to include sending in response to the received response or any other type of messages in order to trigger transmission of CancelLoaction message allowing management of location information.

15. Allison did not teach a SIP proxy user agent and a SIP registrar. Schuster teaches a SIP proxy user agent and a SIP registrar (col. 14, lines 22-31).

16. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Allison and Schuster because Schuster's teaching of SIP proxy user agent and a SIP registrar would increase the functionality of Allison's system by providing Session Initiation Protocol (SIP) registration management on a network.

17. As per claim 2, Allison and Schuster teach the invention substantially as claimed in claim 1 above. Schuster further teach receiving, by the SIP proxy UA, a non-SIP registration request from the remote unit prior to sending the first registration message (col. 14, lines 54-62).

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18. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Allison and Schuster for the same reason as claim 1 above.

19. As per claim 4, Allison and Schuster teach the invention substantially as claimed in claim 1 above. Schuster further teach wherein the first registration message comprises a SIP REGISTER message (col. 14, lines 54-62).

20. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Allison and Schuster for the same reason as claim 1 above.

21. As per claim 5, Allison and Schuster teach the invention substantially as claimed in claim 4 above. Schuster further teach wherein the SIP REGISTER message indicates that it comprises a new contact address (col. 14, lines 54-62).

22. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Allison and Schuster for the same reason as claim 1 above.

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23. As per claim 6, Allison and Schuster teach the invention substantially as claimed in claim 1 above. Schuster further teach wherein the second registration message comprises a SIP REGISTER message (col. 14, lines 54-62).

24. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Allison and Schuster for the same reason as claim 1 above.

25. As per claim 7, Allison and Schuster teach the invention substantially as claimed in claim 1 above. Allison and Schuster further teach wherein the response that indicates a contact address more recent than any provided by the SIP proxy UA comprises a SIP 200 OK message (see Schuster, col. 14, lines 62-65) and at least one creation time stamp (see Allison, page 7, parag. 62).

26. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Allison and Schuster for the same reason as claim 1 above.

27. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Allison and Schuster in view of Sasada, U.S. Patent 6,978,135 (hereinafter Sasada).

28. Sasada was cited in the previous office action.

29. As per claim 3, Allison and Schuster teach the invention substantially as claimed in claim 1 above. Allison and Schuster did not teach a registration timer expiration. Sasada teaches wherein the second registration message is sent in response to a registration timer expiration (col. 8, lines 4-11).

30. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Allison, Schuster and Sasada because Sasada's teaching of second registration message is sent in response to a registration timer expiration would increase the efficiency of Allison's and Schuster's systems by allowing subsequent registration message to be sent automatically.

31. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Allison and Schuster in view of Arrington, Jr. et al, U.S. Patent 5,918,176 (hereinafter Arrington).

32. Arrington was cited in the previous office action.

33. As per claim 8, Allison and Schuster teach the invention substantially as claimed in claim 7 above. Allison and Schuster did not teach a group of contact addresses and a timestamp for each. Arrington wherein the response further comprises a group of contact addresses and a creation time stamp for each (col. 7, lines 9-18, 41-49).

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34. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Allison, Schuster and Arrington because Arrington's teaching of sending a response comprising a group of contact addresses and a creation time stamp for each would increase the efficiency of Allison's and Schuster's systems by allowing multiple fields of information to be sent in a single message, hence reducing the traffic on a network.

35. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Allison and Schuster in view of Narayanan et al, U.S. Patent Application Publication 2003/0220990 (hereinafter Narayanan).

36. Narayanan was cited in the previous office action.

37. As per claim 9, Allison and Schuster teach the invention substantially as claimed in claim 1 above. Allison and Schuster did not teach Register message with expire value of "0". Narayanan teaches wherein the deregistration message comprises a REGISTER message with an Expires header value of "0" (page 8, parag. 82).

38. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Allison, Schuster and Narayanan because Narayanan's teaching of REGISTER message with an Expires header value of "0" would

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increase the efficiency of Allison's and Schuster's systems by allowing registered user to be automatically deregister when the expiration value timeout.

39. Applicant's arguments filed 07/05/07 have been fully considered but they are not persuasive.

40. In the remarks, applicant argued that:

- (1) No amendment is needed for the 35 U.S.C. 112, second paragraph rejection in section 5(a) of the office action.
- (2) The cited prior arts fail to teach sending, in response to the received response, a deregistration message for the remote unit to the SIP registrar.
- (3) The examiner must provide a teaching or suggestion from the prior art to combine the references.

41. In response to point (1), page 8 of the remark filed on 7/5/07, applicant states "the same SIP proxy need not send both registration messages". It is noted that giving the broadest interpretation of the claim language, the limitations includes the embodiment of the same SIP proxy sending both the first and the second registration messages. Since the scope of the claim include the embodiment of the same SIP proxy sending both the first and the second registration messages, it is unclear why two registration messages are sent. Accordingly, the rejection is maintained.

42. In response to point (2), as explained in the rejection of claims 1 and 15 above, the combination of Allison and Schuster teach “sending, in response to the received response, a deregistration message for the remote unit to the SIP registrar”. Specifically, Allison teaches sending, in response to a message (1, fig. 8), a deregistration message (Cancellocation Message, 2, fig. 8) for the remote unit to the registrar (page 8, parag. 68). Allison does not specifically teach all type of messages, however, there is no novelty to include sending, in response to a different message such as the received response presented in the instant claim with Allison’s system. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to include sending in response to the received response or any other type of messages in order to trigger transmission of CancelLoaction message allowing management of location information. Allison did not teach a SIP proxy user agent and a SIP registrar. Schuster teaches a SIP proxy user agent and a SIP registrar (col. 14, lines 22-31). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Allison and Schuster because Schuster’s teaching of SIP proxy user agent and a SIP registrar would increase the functionality of Allison’s system by providing Session Initiation Protocol (SIP) registration management on a network. As shown in figure 8 of the Allison’s reference, a deregistration message is sent for the remote unit from the HLR 104 to the MMR node 300 (2, fig. 8; line 6, fig. 9) (i.e., the deregistration message is sent *to* the registrar).

43. In response to point (3), applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or

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modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art would recognize Schuster's teaching of SIP proxy user agent and a SIP registrar would increase the functionality of a registrar management system by allowing a specific type of proxy user agent and a registrar such as SIP proxy user agent and a SIP registrar to be used in the registrar management of Allison's system, hence enhancing the functionality of Allison's system.

44. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Lee whose telephone number is (571)272-3967. The examiner can normally be reached on 8 AM TO 5:30 PM Monday to Thursday and every other Friday. If attempts to reach the examiner by

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telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

P.L.



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SUPERVISORY PATENT EXAMINER
9/26/17